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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
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09/079,640 05/15/98 DANIELL

EXAMINER

HM12/0910

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ART UNIT	PAPER NUMBER
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DATE MAILED: 1649

09/10/99

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on 7/19/99

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 0 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1-188 is/are pending in the application.
Of the above, claim(s) _____ is/are withdrawn from consideration.
☐ Claim(s) _____ is/are allowed.
☐ Claim(s) _____ is/are rejected.
☐ Claim(s) _____ is/are objected to.
☒ Claim(s) 1-188 are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
☐ The specification is objected to by the Examiner.
☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.
☐ received in Application No. (Series Code/Serial Number) _____
☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☒ Restriction fee cover sheet
☐ Notice of Reference Cited, PTO-892
☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
☐ Interview Summary, PTO-413
☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
☐ Notice of Informal Patent Application, PTO-152

--SEE OFFICE ACTION ON THE FOLLOWING PAGES--

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Please note: In an effort to enhance communication with our customers and reduce processing time, Group 1640 is running a Fax Response Pilot for Written Restriction Requirements. A dedicated Fax machine is in place to receive your responses. The Fax number is 703-305-3704. A Fax cover sheet is attached to this Office Action for your convenience. We encourage your participation in this Pilot program. If you have any questions or suggestions please contact Paula Hutzell, Ph.D., Supervisory Patent Examiner at Paula.Hutzell@uspto.gov or 703-308-4310. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group I, claim(s) 1 and 85, drawn to a vector encoding a non-protein molecule, classified in Class 435, subclass 468, for example.

Group II, claim(s) 2-84, 86-96, 107, 118-119, 122, 168-169, and 171-176, drawn to a vector encoding a peptide and also comprising flanking chloroplast spacer sequences, plants transformed therewith, and a process for obtaining the plants, classified in Class 800, subclass 278, for example.

Group III, claim(s) 97-99, 108-110 and 180-182, drawn to a process for producing a synthetic protein-base polymer, classified in Class 800, subclass 288, for example.

Group IV, claim(s) 100-102 and 104-106, drawn to a process for producing an animal hormone, classified in Class 435, subclass 69.4, for example.

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Group V, claim(s) 103 and 111-113, drawn to a process for producing an insulin-PBP fusion protein, classified in Class 435, subclass 69.7, for example.

Group VI, claim(s) 114 and 120, drawn to an isolated polypeptide, classified in Class 530, subclass 300, for example.

Group VII, claim(s) 115 and 187-188, drawn to a synthetic protein-base polymer, classified in Class 530, subclass 350, for example.

Group VIII, claim(s) 116-117 and 121, drawn to an isolated animal hormone, classified in Class 530, subclass 351, for example.

Group IX, claim(s) 123-151, 170, 177 and 178, drawn to herbicide resistant plants and a process for producing them, classified in Class 800, subclass 300, for example.

Group X, claim(s) 152-153, drawn to a process for determining chloroplast transformation comprising transforming with a vector encoding herbicide resistance and also encoding a second trait of interest, classified in Class 800, subclass 298, for example.

Group XI, claim(s) 160-161, drawn to vectors, classified in Class 435, subclass 320.1, for example.

Group XII, claim(s) 154-159, drawn to insect resistant plants, classified in Class 800, subclass 302, for example.

Group XIII, claim(s) 162-167, drawn to isolated DNA comprising intergenic spacer regions of a chloroplast genome, classified in Class 536, subclass 23.6, for example.

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Group XIV, claim(s) 179 and 183, drawn to a vector comprising non-chloroplast flanking DNA and a non-protein-encoding gene, classified in Class 536, subclass 23.1, for example.

Group XV, claim(s) 184-186, drawn to a chloroplast genome transformed with a vector comprising non-chloroplast flanking DNA and a synthetic protein-base polymer-encoding gene, classified in Class 435, subclass 419, for example.

The inventions are distinct, each from the other because:

Inventions I-XV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different modes of operation and different functions, as set forth below.

Each invention involves physiologically and biochemically divergent products and processes not required by any other, such as genes encoding a multitude of non-proteinaceous products, vectors comprising protein-encoding genes and chloroplast DNA flanking sequences, synthetic protein-base polymer genes, animal hormone-encoding genes, fusion protein-encoding genes, a multitude of isolated polypeptides, a multitude of isolated synthetic protein-base polymers, isolated animal hormones, transformed plants containing herbicide resistance genes, a process for using a vector comprising herbicide resistance genes and additional genes encoding a multitude of traits of interest, vectors comprising a multitude of structural genes and flanking DNA sequences, transformed plants containing insect resistance genes, isolated DNA comprising chloroplast intergenic spacer regions, a vector comprising non-chloroplast flanking DNA and a

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non-protein-encoding gene, and a transformed chloroplast genome comprising a vector comprising non-chloroplast flanking DNA and genes encoding synthetic protein-base polymers.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, classification, and fields of search, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David T. Fox whose telephone number is (703) 308-0280. The examiner can normally be reached on Monday through Friday from 9:30AM to 6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynette Smith, can be reached on (703) 308-3909. The fax phone number for this Group is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

September 8, 1999

DAVID T. FOX
PRIMARY EXAMINER
GROUP ~~180~~ 1649

